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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN WIRTH JR., JAY L. SANGER,
PAUL BRUTSMAN, and DAN STOOPS

Appeal 2009-000648
Application 10/696,587
Technology Center 3700

Decided:¹ June 17, 2009

Before JENNIFER D. BAHR, STEVEN D.A. MCCARTHY, and
KEN B. BARRETT, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

John Wirth Jr., et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-6, 11, 12, 15 and 16. We have jurisdiction under 35 U.S.C. § 6(b).

An oral hearing was held on June 10, 2009.

SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

THE INVENTION

Appellants' claimed invention pertains to a push block having a retractable heel for advancing a workpiece over or through woodworking equipment. (Spec. 1, ¶ [0001].) Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A push block device for displacing a workpiece relative to woodworking equipment, comprising:

a main body having a proximal end, a distal end, a longitudinal axis, and a first, generally flat working surface for engaging a top surface of a workpiece;

a handle component extending from said main body whereby when said first working surface is disposed in parallel facing relation to the top surface of the workpiece, said handle component is disposed predominantly vertically above said main body; and

a heel component extending from said main body so as to have a first, operative position, wherein said heel projects vertically below a first plane of said first working surface, and a second, stored position wherein a bottom edge of said heel is disposed in or vertically above said first plane, said heel defining a second working surface disposed in a second plane defined at an angle with respect to said first working surface,

for selectively engaging a trailing end surface of the workpiece
for displacing the workpiece.

THE REJECTIONS

The Examiner relies upon the following as evidence of
unpatentability:

Misevich	US 4,897,937	Feb. 6, 1990
Hammerschmidt	US 5,369,895	Dec. 6, 1994
Sizemore	US 6,739,075 B2	May 25, 2004

The following Examiner's rejections are before us for review:

1. Claims 1-4, 11, 12, and 15 are rejected under 35 U.S.C. § 102(e) as being anticipated by Sizemore;
2. Claims 5 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sizemore and Misevich; and
2. Claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sizemore and Hammerschmidt.

ISSUES

The Examiner found that Sizemore discloses all of the limitations of Appellants' claim 1. (Ans. 3.) Appellants argue that Sizemore describes a shoe that would not be considered suitable to be a push block, and that Sizemore fails to disclose a handle component and a second working surface disposed in a second plane. (Reply Br. 1.) Appellants also argue that Sizemore does not disclose the heel retention plate of claim 11 or the defined second working surface of claim 15. (*Id.* at 2-3.) Therefore, the first issue on appeal is:

Have Appellants shown that the Examiner erred in finding that Sizemore discloses all of the limitations of the claims subject to the anticipation rejection?

The Examiner concluded that the subject matter of claims 5 and 6 is obvious based on the finding that Misevich teaches molding a slip resistant pad over a working surface. (Ans. 5.) Appellants contend that Misevich does not teach securing a slip resistant pad to a working surface. (Reply Br. 3.) Thus, another issue for our consideration is:

Have Appellants shown that the Examiner erred in finding that Misevich teaches molding a slip resistant pad over a working surface?

The Examiner concluded that the subject matter of claim 16 is obvious based on the finding that Sizemore discloses a shoe with both the upper portion and the sole portion made from rubber, and that rubber is a plastic material. (Ans. 10.) Appellants contend that the skilled artisan would not understand Sizemore to disclose both shoe portions made from plastic, and contend that rubber is not a plastic. (Reply Br. 3-4.) Thus, another issue for our consideration is:

Have Appellants shown that the Examiner erred in finding that Sizemore teaches a shoe having an upper and lower portion made from plastic?

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence.

1. Sizemore discloses a shoe having cleat-like shock absorbers. (Sizemore, col. 1, ll. 65-66.) Figure 1 of Sizemore is reproduced below:

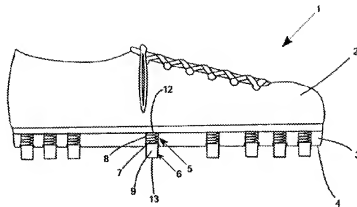


Figure 1 depicts a side view of an embodiment of Sizemore's shoe with the shock absorber springs in the uncompressed condition. (*Id.*, col. 2, ll. 3-5.) Sizemore's shoe has an upper portion 2, a sole portion 3, a bottom surface 4 of the sole (designed as a contact walking surface of the shoe), cleats 6, and a strong wall, or top retaining wall 12, to enclose spring 7. (*Id.*, col. 2, ll. 47-65; col. 3, ll. 36-38.)

2. Sizemore's shoe is capable of "displacing a workpiece relative to woodworking equipment," as recited in the preamble of Appellants' claim 1.

3. The side of Sizemore's cleat 6 defines a curved surface. (*See* Sizemore, fig. 2; *see also* Ans. 9.) If the side of a cleat 6 was pushed against a workpiece, the cleat would impart a force on that workpiece. Therefore, the cleat defines a surface that is a working surface. Sizemore's figures depict the sides of the cleats disposed approximately perpendicular to the sole portion 3 of the shoe. (*See, e.g., id.*, figs. 1, 2.) Thus, at least a portion of the working surface defined by cleat 6 lies in a plane at an angle with respect to the bottom surface of the shoe. The defined curved working surface extends widthwise relative to the sole portion of the shoe, and

generally faces toward the front of the shoe. (*See id.*, fig. 2; *see also* Ans. 9.)

4. Sizemore states that “[u]pper portion 2 and sole 3 [of the shoe] may be made of any number of conventional materials (e.g. leather, rubber, etc.) to fit the comfort and styles preferred by the user.” (Sizemore, col. 2, ll. 49-53.)

PRINCIPLES OF LAW

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). It is the Appellants’ burden to precisely define the invention, not that of the United States Patent and Trademark Office. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997) (citing 35 U.S.C. § 112, ¶ 2). Appellants have the opportunity to amend the claims during prosecution, and broad interpretation by the Examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *Prater*, 415 F.2d at 1404-05.

“It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (citations omitted).

If ... the body of the claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the preamble offers no distinct definition of any of the claimed invention’s limitations, but rather merely states, for example, the purpose or intended use of the invention, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.

Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305 (Fed. Cir. 1999) (citations omitted).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987) (citations omitted).

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 407 (2007) (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”). The analysis supporting an obviousness rejection “need not seek out precise teachings directed to the specific subject matter of the challenged claim.” *KSR Int’l Co.*, 550 U.S. at 418. However, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (citations omitted) (cited approvingly in *KSR Int’l Co.*, 550 U.S. at 418).

ANALYSIS

The Rejection of Claims 1-4, 11, 12, and 15 under 35 U.S.C. § 102(e) as Being Anticipated by Sizemore

Claims 1 and 2-4

Appellants argue claims 1 and 2-4 as a group. (App. Br. 10-12.) We select claim 1 as the representative claim, and claims 2-4 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

Appellants first argue that “Sizemore clearly has nothing to do with a push block device for displacing a workpiece relative to woodworking equipment as recited in applicant’s independent claim 1.” (App. Br. 10.) Appellants are referring to language found in the preamble of claim 1. This language is a statement of purpose or intended use, and does not constitute a limitation or explain any limitation in the body of the claim. Thus, the preamble language does not serve to patentably distinguish the claimed structure from Sizemore’s device. Furthermore, Sizemore’s shoe is capable of displacing a workpiece relative to woodworking equipment. (Fact 2.) Therefore, it has the functionality recited in the preamble.

Appellants next argue that Sizemore’s shoe upper portion 2 is not the recited “handle component.” (App. Br. 11.) We give pending claims their broadest reasonable construction consistent with the specification. *Prater*, 415 F.2d at 1404-05. The language of claim 1 does not specify the shape or configuration of the handle component. Appellants’ Specification supports a broad interpretation of the phrase “handle component.” (See Spec. 5-6, ¶ [0023] (stating that the handle can be U-shaped with legs and a grip, as shown in the illustrated embodiment, or “could be another shape and configuration[.]”).) Appellants contend that one of ordinary skill would understand a “handle” to be a part that is held (App. Br. 11), while

conceding that “[Sizemore’s shoe] can be grasped by hand” (Reply Br. 1). Appellants offer no persuasive evidence to support the conclusion that the ordinary artisan would not consider Sizemore’s upper portion 2 to be a handle (*see* App. Br. 11). As such, we are not persuaded that the Examiner erred in finding that Sizemore’s shoe upper constitutes a “handle component” when the claim is given the broadest reasonable construction consistent with the Specification.

Appellants also argue that claim 1 requires that the heel define a planar second working surface, and that the Examiner erred in finding that cleats having a curved surface constitute the recited heel (*see* Ans. 3, 8-9). (Reply Br. 2.) We are not persuaded by Appellants’ argument that the second surface of claim 1 is “limited to a planar surface” (Reply Br. 2). The language of claim 1 does not contain the word “planar” and does not require that the heel define a working surface entirely in a single plane. Rather, the claim merely requires a “heel defining a second working surface disposed in a second plane defined at an angle with respect to said first working surface” Sizemore’s curved cleat 6 defines a working surface in that the cleat, when pushed against a trailing end of a workpiece, will impart a force on that workpiece. (Fact 3.) That second working surface lies at least partially in a plane at an angle to the first working surface. (*Id.*) Thus, Sizemore discloses a heel defining a second working surface as recited in Appellants’ claim 1.

Appellants have not shown that the Examiner erred in rejecting claim 1 as anticipated by Sizemore. Accordingly, we sustain the rejection of claim 1, as well as the rejection of claims 2-4, which fall with claim 1.

Claims 11 and 12

Claim 11 depends from independent claim 1, and recites “a retention plate for securing said retractable heel to said main body.” The Examiner found that Sizemore’s element 12 corresponds to Appellants’ recited retention plate. (Ans. 8.) Appellants argue that there is no disclosure in Sizemore of wall 12 as providing “for securing said retractable heel to said main body” as recited in claim 11. (App. Br. 12.)

Sizemore’s wall 12 encloses the spring so as to protect the wearer from discomfort due to spring pressure and serves to retain the spring within the cleat 6 (*see* Sizemore, col. 2, ll. 61-65; *id.*, col. 3, ll. 36-38). However, the Examiner does not direct our attention to any disclosure of the wall 12 serving the recited function of securing the heel (cleat 6) to the main body (sole portion 3). Accordingly, we are constrained to reverse the rejection of claim 11 and the rejection of claim 12, which depends from claim 11, as anticipated by Sizemore.

Claim 15

Claim 15 depends from claim 1 and recites that the second working surface “generally faces in a direction of said leading half [of the main body] and extends widthwise of said main body.” Appellants argue that the cleat’s curved peripheral surface is not planar (as purportedly required by claim 1) and does not extend widthwise. (Reply Br. 3.) As discussed above, claim 1 does not require a planar surface. To the extent that Appellants contend that the claim requires the working surface to extend the entire width of the block body (*see* App. Br. 12), we disagree. Given the broadest reasonable construction, a defined surface “extends widthwise” when it extends for any

distance in a side-to-side direction relative to the body. (*See* Spec., fig. 2 (depicting heel 30 as extending less than the full width of the main body 12).) Sizemore's cleat defines a curved working surface that extends widthwise in a direction relative to the push block body, and that generally faces in the direction of the leading half of the body. (Fact 3.) As such, we find no error in the Examiner's rejection of claim 15 as anticipated by Sizemore.

The Rejection of Claims 5 and 6 under 35 U.S.C. § 103(a) as Being Unpatentable Over Sizemore and Misevich

Independent claim 5 recites "at least one slip resistant pad secured to at least one of said first and second working surfaces." The Examiner found that "Sizemore fails to teach molding a slip resistant pad over the working surface 4," and relies on Misevich for the teaching of a slip resistant pad. (Ans. 5, 10.) Specifically, the Examiner found that "Misevich teaches molding a slip resistant pad over a working surface" (*id.* at 5 (citing Misevich, col. 2, ll. 2-15)). The Examiner may be referring to Misevich's statement that the insole base pattern can be molded onto a fabric sheet which may then be "adhered to the bottom of the shoe." (Misevich, col. 2, ll. 9-15.) As Misevich's non-slip pattern faces the inside of the shoe so as to hold the insole in place (*id.*), it appears that this statement means that the patterned sheet may be adhered to the top of the bottom layer of the shoe (corresponding to the sole portion 3 of Sizemore) rather than the bottom of the entire shoe assembly (the part that touches the ground, i.e. working surface 4 of Sizemore). Thus, Misevich's statement regarding the bottom of the shoe does not support a finding that Misevich teaches securing a slip resistant pad to a working surface of the shoe.

The Examiner also found that Misevich teaches providing a slip resistant pad for an outsole of a shoe. (Ans. 10 (citing Misevich, col. 5, figs. 11, 12).) In the pertinent embodiments of Misevich, the slip resistant pad is the outsole itself (elements 70 and 80), and does not appear to be secured to a working surface. (See Misevich, col. 5, ll. 20-41, figs. 11, 12.)

On the record before us, we cannot find by a preponderance of the evidence that Misevich teaches a slip resistant pad attached to a working surface as recited in Appellants' claim 5. Thus, the Examiner's articulated reason for the modification lacks a rational underpinning, and we cannot sustain the rejection of claim 5 or the rejection of claim 6, which depends from claim 5.

The Rejection of Claim 16 under 35 U.S.C. § 103(a) as Being Unpatentable Over Sizemore and Hammerschmidt

Claim 16 depends from independent claim 1 and recites "said push block main body and handle are molded from a plastic material." The Examiner bases the conclusion of obviousness on the finding that Sizemore teaches that both the upper portion 2 and the sole portion 3 are made from "rubber which is plastic." (Ans. 10 (citing Sizemore, col. 2, ll. 47-53).) The statement in Sizemore relied upon by the Examiner teaches that a shoe may be made from conventional materials such as leather and rubber, but does not rise to the level of teaching that both the upper and sole portions are made from rubber. (See Fact 4.) Further, we cannot find by a preponderance of the evidence that Sizemore's passing reference to rubber as a shoe material constitutes a teaching that the upper and sole portions are made from a plastic material. The Examiner appears to rely on Hammerschmidt only for the teaching that plastic shoes may be made by a

molding process. (Ans. 5, 10.) The Examiner has not articulated any reasoning, with rational underpinning, as to why a person of ordinary skill in the art would have been prompted by Hammerschmidt's teaching of plastic clogs to mold the upper and sole portions of Sizemore's shock-absorbing footwear (push block) from plastic. Accordingly, we are constrained to reverse the rejection of claim 16.

CONCLUSIONS

We conclude that Appellants have shown that the Examiner erred in finding that Sizemore discloses the heel retention plate of claim 11. Thus, Appellants have shown that the Examiner erred in rejecting claims 11 and 12 as anticipated by Sizemore.

We also conclude that Appellants have shown that the Examiner erred in finding that Misevich teaches molding a slip resistant pad over a working surface. Thus, Appellants have shown that the Examiner erred in rejecting claims 5 and 6 as being unpatentable over Sizemore and Misevich.

We further conclude that Appellants have shown that the Examiner erred in finding that Sizemore teaches a shoe having an upper portion and a lower portion made from plastic. Thus, Appellants have shown that the Examiner erred in rejecting claim 16 as being unpatentable over Sizemore and Hammerschmidt.

However, we conclude that the Appellants have failed to show that the Examiner erred in finding that Sizemore discloses all of the limitations of claims 1 and 15. Thus, Appellants have not shown that the Examiner erred in rejecting claims 1-4 and 15 as anticipated by Sizemore.

DECISION

The decision of the Examiner to reject claims 5, 6, 11, 12 and 16 is reversed. The decision of the Examiner to reject claims 1-4 and 15 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

mls

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